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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,918	11/20/2000	Jay S. Walker	98-010-C1	9324
22927 7590 01/08/2008 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905			EXAMINER LEIVA, FRANK M	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 01/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/716,918	Applicant(s) WALKER ET AL.	
	Examiner Frank M. Leiva	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/31/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is responsive to the RCE filed 31 October 2007, and answering to the arguments and claims filed 13 April 2007.
2. The claims filed 13 April 2007 have not been amended and since the rejections filed 08 December 2006 are deemed proper they are hereby incorporated in this action.

Response to Arguments

3. Applicant's arguments filed 13 April 2007 have been fully considered but they are not persuasive. For the following reasons:

4. To the argument directed to the rejections of claims **50, 71 and 74**; "Barrie *neither teaches nor suggests*:"

- *determining a number of occurrences of the at least one tracked symbol*
- *determining whether the number is' at least a minimum number, and*
- *providing, if the number is' at least a minimum number, a bonus payout",*

the office action uses Fig. 5 embodiment explained in (col. 6:31-38), "In the embodiment of FIG. 5, a persistent symbol such as a check mark is positioned in each number location selected by the user in the previous step 516. The system then determines whether a minimum number, such as all of the symbol positions on the simulated keno card, have been filled with check marks 518, and, if so, a special prize 520, based on the presence of the persistent symbols is ordered", which calls the tracked symbol (persistent),

and that it determines a "minimum number" and that it awards a "special price" when the number is reached independently from the game outcome.

5. To the argument of claims **50, 71 and 74** continued on pages 16 and 17 of applicant's remarks; *"Applicants note that this description contains numerous logical inconsistencies that render a clear understanding of the teaching unobtainable", "Put, simply, the disclosure is both unclear and logically inconsistent. In addition, the Examiner's perception of the teachings of Barrie, while perhaps superficially plausible, suffers of necessity from the underlying defects in the disclosure of Barrie", "A problem therefore arises when Barrie discloses that "In the embodiment of FIG. 5, a persistent symbol such as a check mark is positioned in each number location selected by the user in the previous step 516." (emphasis added)",* The examiner will now point to the basics of a Keno game well known in the art in order to cover the information that the applicant deems inconsistent.

6. Keno; a game which picks 20 numbers out of a possible 80 numbers one (1) through eighty (80) in each game and the object of the game is for the player to guess which numbers the game will select in the round, and be paid odds in accordance to the amount of numbers the player selected versus the amount of numbers the player actually guess correctly. The game consists of a board with all 80 numbers in square block and in most embodiments the player selects the picks by placing a RED check mark on the numbers the player is guessing the game is going to select, and as the game outcomes the 20 selected numbers, the game changes the RED check mark with a GREEN check mark on the numbers the player guess correctly.

7. For the purpose of Barrie's Keno embodiments, the game tracks the number of GREEN check marks that the player has actually guess right and fills a small board on the side of the display that indicates how many the player has accumulated and how many the player still needs to gain in order to reach the "special prize". This information

is obvious when viewed from the alternative embodiments of Barrie in which Slots or Bingo games are implemented.

8. To the argument of claims **50, 71 and 74** continued on page 19 of applicant's remarks; "*The Examiner continues by asserting that Barrie checks if it (the tracked symbol) reaches a certain number at #518. Presumably, the Examiner is inferring that Barrie keeps track of the number of check marks and checks to see if this number "reaches a certain number #518". However, as described above, there is no reasonable and logically consistent interpretation of Barrie that involves providing a bonus payout when the number of check marks reaches a minimum. As noted above, regardless of the conflicting assumptions under which one proceeds to interpret the teachings of Barrie, it is clear that the number of check marks is at a maximum at the commencement of the game, that the number of check marks decreases over time, and that it is this decreasing number that triggers a payout when it equals some minimum number"* , the examiner points to Fig. 5 and 7 to illustrate, Barrie's "grid" of Fig. 5 would show something as in Fig. 7, and 518 asks if it is filled as to checking if the minimum number of check marks has been reach for the prize payout. The examiner fails to understand how a person of ordinary skill in the art cannot equate filling up a grid with symbols as tracking them and reaching a limit or minimum count to win a prize. The examiner deems all the limitations of claims 50, 71 and 72 are shown or expressed in the Barrie disclosure and that the rejections are deemed proper.

9. To the argument of claim 72 on page 20 of applicant's remarks; "*Barrie neither teaches nor suggests:*

- *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is*

decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence.

Applicants respectfully reassert that Barrie does not teach or suggest any collection of symbols, much less providing a payout if a minimum number of symbols are collected” , as expressed above Barrie's abstract shows the collection of symbols; a count value in Fig. 1 and a minimum number in Fig. 5 and 7, and expirations of those symbols are well disclosed in the abstract. The examiner deems argument not persuasive and rejection of claim 72 proper.

10. *To the argument on page 21 of applicant's remarks; “Applicants respectfully assert that the Examiner is in error when interpreting and applying the teachings of Barrie. Specifically, Applicants respectfully assert that Barrie does not teach, at the Examiner's citation or elsewhere, incrementing a count value of the occurrences of a tracked symbol and decreasing the count value when the occurrence of the tracked value expires”, the examiner hopes that in view of the above well known description of a Keno game that the applicant can now understand Barrie's disclosure more effectively. As to the argument been too broad and not specific to which limitation the applicant refers to.*

11. *To the argument in page 24 of applicant's remarks; “The stated motivations are merely statements of asserted advantages that may be realized from the proposed motivations. The motivations do not appear as objective teachings in the record that would have motivated one of ordinary skill in the art to make the proposed modifications, as is required”, as realized by the KSR rulings the motivations to*

combined known systems and methods that would yield a predictable result is not novel but mostly design choice or obvious to try.

12. To the argument of claims **55, 59 and 63** on page 24 of applicant's remarks; please refer to above response to claims 50, 71 and 74.

Conclusion

13. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Leiva whose telephone number is (571) 272-2460. The examiner can normally be reached on M-Th 9:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

12/20/2007


XUAN M. THAI
SUPERVISORY PATENT EXAMINER